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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,059	06/15/2006	Rene Johan Haan	TS1391 US	8848
	7590 01/03/2008	EXAMINER		
SHELL OIL COMPANY P O BOX 2463			NAGUBANDI, LALITHA	
HOUSTON, T	X 772522463		ART UNIT	PAPER NUMBER
			1621	
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			MAIL DATE	DELIVERY MODE
			01/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary Examiner			Application No.	Applicant(s)			
Lalitha Nagubandi The MAILING DATE of this communication appears on the cover sheet with the correspondence address — Period for Reply A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions from many be available under the provision of 3 CPR 1.135(a), in no event, mover, may a reply be timely filed If NO period for reply is specified above, the maintain statistical period will apply and will expire SX (6) MONTHS from the maling date of this communication. Failuse to require them adjustment. See 37 CPR 1.734(b). Status 1) Responsive to communication(s) filed on 15 June 2006. 23) This action is FINAL. 2b) This action is non-final. 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. Disposition of Clalms 4) Claim(s) 1-20 is/are pending in the application. 4) Claim(s) 1-20 is/are pending in the application. 4) Claim(s) 1-20 is/are rejected. 7) Claim(s)			10/583,059	HAAN ET AL.			
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2) ☐ Notice of Dramsperson's Patent Drawing Review (P10-948) 3) ☑ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 6/15/2006. 5) ☐ Notice of Informal Patent Application 6) ☐ Other:	1) Notice	te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da 5) Notice of Informal Pa	ite			

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Detailed Action

Status of the Claims

1. Claims 1-20 are pending. Claims 1-20, are considered for examination in this office action.

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware of in the specification.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

Claims 1- 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kummer et al (US Pat. No. 4,777,285 dated Oct. 11, 1988).

3. Applicants' claim a process for the preparation of an alkyl alkenoate startting from a lactone of general molecular formula:

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The process embodies, reaction of the above lactone with a C_1 - C_4 alkyl alcohol in a liquid phase in the presence of a *strong acid catalyst* at transesterification conditions to form the alkyl alkenoate, wherein alkyl alkenoate and alcohol are continuously removed from the liquid phase by *distillation*.

The process is carried out at a temperature in the range of from 100 to 300^{0} C and the pressure in the reaction zone is in the range of from 0.01 to 10 bar (absolute). Further, the process embodies the lactone to be gamma valerolactone and the alkyl alkenoate as alkyl pentenoate.

Kummer et al disclose, a process for the preparation of alkenecarboxylates starting from lactones and using alkanols. (see col.1, lines 45-55).

The reaction was carried out from 150° to 400°C and the pressure being in the range of 0.5 to 10 bar. The process discloses the list of suitable acidic catalysts suitable for liquid phase reaction.

Further, the process discloses the advantage of obtaining the desired product, the alkenecarboxyate by fractional distillation (see col 2, lines 40-45).

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Although the disclosed prior art does not exemplify the use of gamma valerolactone as embodied in **claim 6**, the instant process is inherently taught in the reference with enough guidance which can be practiced by an ordinary artisan. An ordinary artisan can further extend the process to other valerolactones, such as the gamma valerolactone.

Thus the instant claims are rejected based on the fact that, the claiming of a new use, new function or unknown property which is *inherently* present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430,433 (CCPA 1977). *In re Crish*, 393 F.3d 1253, 1258,73 USPQ 2d 1364, 1368 (Fed. Cir. 2004), The court states that "just as the discovery of properties of a *known material* does not make it novel, the identification and characterization of a prior art material also does not make it novel". Please see MPEP 2112.

Conclusion

4. No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalitha Nagubandi whose telephone number is 571 272 7996. The examiner can normally be reached on 6.30am to 3.30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne, Eyler can be reached on 571 272 0871. The fax

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phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from

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direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or

access to the automated information system, call 800-786-9199 (IN USA OR

CANADA) or 571-272-1000.

Lalitha Nagubandi Patent Examiner

Technology Center 1600

December 27th, 2007.

Samuel A Barts

Primary Patent Examiner

Technology Center 1600